



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,885	08/17/2001	Bruno Tisserand	Q65570	5990

7590 12/30/2004
Sughrue Mion Zinn Macpeak & Seas
2100 Pennsylvania Avenue NW Suite 800
Washington, DC 20037-3213

EXAMINER

NGUYEN, TRONG NHAN P

ART UNIT	PAPER NUMBER
----------	--------------

2152

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	Application No. 09/913,885	Applicant(s) TISSERAND ET AL.	
	Examiner Jack P Nguyen	Art Unit 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/05/01</u> | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
6) <input type="checkbox"/> Other: _____ |
|---|---|

DETAILED ACTION

Claims 1-9 are being examined.

Information Disclosure Statement

The information disclosure statement filed 11/05/01 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Document EP 1009153 is not considered because there is no English translation of the document nor an explanation of relevant. It has been placed in the application file, but the information referred to therein has not been considered.

Specification

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)),

Art Unit: 2152

and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention

described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (k) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

The content of the Specification lacks some of the following relevant sections: e – Background of the Invention; f – Summary of the Invention; g – Brief Description of the Drawings, etc. The layout of the Specification is suggested above. Applicant is suggested to use this format when filing the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, and 8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 states, "...the called party and/or a reply..." This is indefinite because it is unknown if applicant intends to include or exclude the first or second part of the claim. For the purpose of examination, Examiner interprets the 'or' part of the claim, i.e., the claim can refer to either section of the claim. Claims 2 and 8 follow this same interpretation taken by Examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-2, 4-5, and 7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Willhoff, 6,728,548 (Willhoff hereafter).

As per claim 1, Willhoff teaches a method of sending a user message through a transmission network (abstract), the method being characterized in that: a request is activated to set up a call channel between a caller and a called party (col. 6, lines 37-39; mobile device requests channel set up to initiate a call); to set up the call channel, a signaling stage is performed during which a signaling message containing at least one spare field is interchanged between the caller and the called party (col. 5, lines 52-55;

mobile device loads message data into a spare field (user data unit field), i.e., a field that has not been used, before transmitting the message to recipient); and in that: before the interchange between the called party and the caller, the user message is placed in the spare field of the signaling message (col. 5, lines 52-55; see interpretation above); and the setting up of the call channel is terminated once the user message has been received by the called party (col. 7, lines 30-33; upon receiving user message by receiving device, system terminates call channel).

Claim 8 recites similar limitations to claim 1; therefore, it is rejected for similar reasons as claim 1 addressed above. Willhoff further teaches the transceiver device (fig. 1; col. 4, lines 41-42) for receiving a reply to the user message from a called party (col. 7, lines 22-24; BMI (called party) sends acknowledgement to mobile device after receiving the message), said device being characterized in that it includes a dedicated memory (24, fig. 1), the dedicated memory serving to store the user message (col. 5, lines 3-6).

As per claim 2, Willhoff teaches the user message is stored in a dedicated memory of the receiver of the user message (col. 7, lines 11-15; upon receiving the user message, the receiving device (BMI) temporarily stores the message before extracting the message for user data unit).

As per claims 4 and 5, Willhoff teaches the dedicated memory is placed in a mobile telephone (col. 4, lines 62-65), the mobile telephone being used as a modem (18b, fig. 1; col. 4, lines 43-44; mobile device functions as a wireless modem to connect to wireless network), and the transmission network then being a mobile telephone

network (col. 4, lines 41-44); the dedicated memory is placed in an ISDN-type modem (inherent in ISDN-typed network), the modem making it possible to connect the caller to the called party via an ISDN used as a transmission network (70, fig. 5, col. 9, lines 24-31; communications between devices can be routed through wired network as well, i.e., via ISDN-typed network).

As per claim 7, Willhoff teaches the user message is enciphered with an enciphering key prior to being transmitted; and the user message is deciphered with a deciphering key on being received (60, 62, fig. 5; col. 8, lines 54-56; encryption key is used to encrypt and decrypt message data).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 6, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willhoff, 6,728,548 (Willhoff hereafter).

As per claim 3, Willhoff does not explicitly disclose a user is authorized to access the dedicated memory by means of specific commands. However, it is well known in the art for authorized users to access protected data using commands such as userid and password or PIN (personal identification number). Hence, it would have been obvious to one of ordinary skill in the art to apply security parameters to protected data

in order to prevent unauthorized access to privileged data.

As per claims 6 and 9, Willhoff does not explicitly disclose the size of a user message is limited to 35 eight-bit bytes at maximum or dedicated memory is no more than 35 bytes. However, Willhoff teaches the size of a user message or memory can be of any value according to the user's requirements (col. 13, lines 10-15). Hence, it would have been obvious to one of ordinary skill in the art to modify Willhoff teachings by setting specific maximum values to the size of the messages or memory storage to save costs and/or bandwidth.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Cubbage et al, 6,606,486; Arnold et al, 5,337,044; Kennedy et al, 6,018,657; Helferich, 6,696,921; Payne et al, 6,021,433; Hsu et al, 5,661,790; Alanara, 5,604,921

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack P Nguyen whose telephone number is (571) 272-3945. The examiner can normally be reached on M-F 8:30-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2152

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jpn



Dung C. Dinh
Primary Examiner